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EXAMINER

NEGRON, ISMAEL

ART UNIT PAPER NUMBER

2875

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,488

Applicant(s)

TUFTE, BRIAN N.

Examiner

Ismael Negron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27 is/are allowed.
- 6) ☒ Claim(s) 1,3-14 and 18-26 is/are rejected.
- 7) ☒ Claim(s) 15-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/22/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on December 15, 2004 has been entered. Claims 1, 12, 18, 23, 24 and 27 have been amended. No claim has been added or cancelled. Claims 1 and 3-27 are still pending in this application, with claims 1, 11, 12, 18, 23, 24, 26 and 27 being independent.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the legs being spaced along the length of the elongated member (claim 8) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 1-8, 11-14 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over BROOKMAN (U.S. Pat. 5,337,225).

BROOKMAN discloses an illumination device having:

- **an elongated member having a cavity**, Figure 4, reference number 82;
- **an elongated light source for being received in the cavity**, Figure 4, reference number 74;
- **the cavity being at least partially defined by a material that is at least partially transparent**, Figure 4, reference number 86;
- **the cavity being also at least partially defined by a material that is at least substantially non-transparent**, Figure 4, reference number 84;
- **the elongated member having two legs adapted to secure the elongated member to a support member**, Figure 4, reference numbers 90 and 92;
- **the first material and the second material being integrally formed**, Figure 4 and column 3, lines 61-63;
- **the first and second material being formed separately and secured later together**, Figure 4;
- **the legs extending continuously along the length of the member**, columns 3 and 4, lines 65-67 and 1-3, respectively; and

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- **the elongated member being made of a elastomeric material,**
column 3, lines 61 and 62.

In addition, BROOKMAN discloses a second embodiment having:

- **an elongated member having a cavity,** Figure 2, reference number 32;
- **an elongated light source for being received in the cavity,** Figure 2, reference number 24;
- **the cavity being at least partially defined by a material that is at least partially transparent,** Figure 2, reference number 36;
- **the cavity being also at least partially defined by a material that is at least substantially non-transparent,** Figure 2, reference number 34;
- **a support member,** Figure 2, reference number 40;
- **the support member having two legs adapted to secure the elongated member,** Figure 2, reference numbers 42;
- **the legs engaging the back surface of the elongated member,** column 3, lines 25-28; and
- **the legs having laterally extending teeth,** Figure 2.

BROOKMAN discloses all the limitations of the claims, except the elongated member including legs with laterally extending teeth for securing the elongated member to a back surface of a relatively flat substrate.

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It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use the legs with laterally extending teeth of the support member of BROOKMAN to secure the elongated member to the support member, but also to secure such support member to a relatively flat substrate, since the use of such legs is old and well known in the art as evidenced by BROOKMAN. In addition, BROOKMAN states that the support member could be fastened by any of the mechanical fasteners known in the art, of which the disclosed legs is merely one.

4. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over BROOKMAN (U.S. Pat. 5,337,225).

BROOKMAN discloses, or suggests (see Section 3 of the instant Office Action), all the limitations of the claims, except the elongated light source being an electro luminescent wire (ELEW) or a linear emitting fiber (LEF).

The examiner takes Official Notice that the use of ELEW and LEF is old and well known in the illumination art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute an ELEW or LEF for the light source in the system of BROOKMAN. One would have been motivated since ELEW are recognized in the illumination art to have many desirable advantages, including high efficiency, low power consumption, long life, resistance to vibrations, and low heat production, over other light sources.

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5. Claims 18-20 is rejected under 35 U.S.C. 103(a) as being unpatentable over BROOKMAN (U.S. Pat. 5,337,225).

BROOKMAN discloses an illumination device having:

- **a relatively planar substrate**, Figure 2, reference number 40;
- **an elongated member having a cavity**, Figure 2, reference number 32;
- **an elongated light source for being received in the cavity**, Figure 2, reference number 24;
- **the cavity being at least partially defined by a material that is at least partially transparent**, Figure 2, reference number 36;
- **the cavity being also at least partially defined by a material that is at least substantially non-transparent**, Figure 2, reference number 34;
- **the substrate having two legs adapted to secure the elongated member**, Figure 2, reference number 42;
- **the first material and the second material being integrally formed**, Figure 4 and column 3, lines 61-63;
- **the first and second material being formed separately and secured later together**, Figure 4;
- **the legs extending continuously along the length of the substrate**, columns 3 and 4, lines 65-67 and 1-3, respectively;

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- **the elongated member being made of a elastomeric material,**
column 3, lines 61 and 62
- **the legs having a laterally extending tooth,** Figure 1, reference
number 42.

BROOKMAN discloses all the limitations of the claims, except the substrate including a material that can be initially provided in a liquid or semi-liquid state, and then cured or hardened to a more solid state around the legs.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the legs of BROOKMAN into the elongated member instead of the substrate, since it has been held that rearranging or reversal parts of a prior art structure involves only routing skill in the art. *In re Japikse*, 86 USPQ 70, and *In re Gazda*, 219 F.2d 449, 104 USPQ 400 (CCPA 1955)

In addition, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the material used by BROOKMAN (e.g. polymeric materials) can be initially provided in a liquid or semi-liquid state, and then cured or hardened to a more solid state around the legs. See column 4, lines 10-12 of BROOKMAN.

6. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over BROOKMAN (U.S. Pat. 5,337,225).

BROOKMAN discloses, or suggests (see Section 5 of the instant Office Action), all the limitations of the claims, except the elongated light source being an electro luminescent wire (ELEW) or a linear emitting fiber (LEF).

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The examiner takes Official Notice that the use of ELEW and LEF is old and well known in the illumination art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute an ELEW or LEF for the light source in the system of BROOKMAN. One would have been motivated since ELEW are recognized in the illumination art to have many desirable advantages, including high efficiency, low power consumption, long life, resistance to vibrations, and low heat production, over other light sources.

Allowable Subject Matter

7. Claim 27 is allowed.
8. Claims 15-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. The following is a statement of reasons for the indication of allowable subject matter:

Applicant teaches a lighting apparatus having an elongated body having a removable portion with a cavity for receiving an elongated light source. The removable portion being adapted to be selectively removable from the remainder of the elongated body a cavity to provide access to the elongated light source.

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No prior art was found teaching individually, or suggesting in combination, all of the features of the applicants' invention, specifically elongated body having the claimed removable portion.

Response to Arguments

10. Applicant's arguments filed December 15, 2003 have been fully considered but they are not persuasive.

11. Regarding the Examiner's rejection of claims 1, 12, 18 and 23 under 35 U.S.C. 103(a) as unpatentable over BROOKMAN, the Applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically the elongated member having legs that extend into the relatively planar substrate. In addition, the Applicant argues that the first and second materials cannot be integrally formed and separately formed and later secured together, as such statements are mutually exclusive.

12. In response to this argument the Examiners directs the Applicant to Figure 2 of BROOKMAN. An elongated member 32 is attached to a support member 40 by means of a plurality of legs 42, such legs having teeth projecting laterally from such legs 42. Using such leg structure to attach the support member not only to the elongated member 32 but also to the substrate 38, would have flown naturally to one of ordinary skill in the art to simplify such attachment.

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13. In response to the “integrally formed” argument, the Applicant is advised that it has been held that the term “*integral*” is sufficiently broad to embrace construction means such as fastening, gluing and welding. *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973). In this case, while both the first and second materials might have being formed separately, BROOKMAN discloses the elongated member as a single, integral, structure formed by both the first and second materials.

14. Regarding the Examiner’s rejection of claim 23 under 35 U.S.C. 103(a) as unpatentable over BROOKMAN, the Applicant further argues that the cited reference fails to provide motivation for the proposed modification, and that the patented structure includes a plurality of elements which prevent such modification.

In response to this argument it is noted that the claimed invention structure, as defined by claim 23, does not includes an elongated light source. Claim 23 defines a lighting apparatus with the indented use (emphasis added) of receiving an elongated light source.

However, even if (in arguendo) such elongated light source is considered as a critical element of the claimed invention the light source structure of BROOKMAN is considered to meet the claim limitations. Individual light sources 74 form, when taken as a group, an elongated light source for the patented structure.

Even further, substituting the light source of BROOKMAN with the specific light source claimed by the Applicant would have been an obvious improvement since such light sources are widely recognized to be more flexible, efficient and longer lasting than the light sources of BROOKMAN.

Regarding the cited reference having a plurality of elements which prevent the proposed modification, the Applicant is reminded that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case removing the light sources of BROOKMAN and placing the claimed light source in its place would have not required the removal of the oppositely charge wires of BROOKMAN, but even if it did such modification would have required nothing more than ordinary skill in the art.

15. Regarding the Examiner's rejection of claim 8 under 35 U.S.C. 103(a) as unpatentable over BROOKMAN, the Applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically the legs being spaced along the length of the elongated member.

BROOKMAN discloses (Figure 2) a pair of legs 42 being spaced from one another, but fails to indicate if such legs are continuous body along the length of the elongated member 32, or a plurality of separated elements. It is the Examiner's opinion that using a continuous leg or a plurality of discrete leg would have being an obvious matter of design choice dictated by the particulars requirements of any given application and that the structure disclosed by BROOKMAN would function equally well with each alternative. Such lack of criticality is suggested by BROOKMAN's broad disclosure. It is

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also noted that the applicant's own disclosure fails to provide a functional difference between both structures, further suggesting their functional equivalence.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negrón whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached at (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.



ALAN CARIASO
PRIMARY EXAMINER


Inr

February 26, 2004